IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Ken IZUMORI et al.**

Group Art Unit: **1652**

Application Number: **10/541,822**

Examiner: **Mohammad Y. Meah**

Filed: **February 13, 2006**

Confirmation Number: **8335**

For: **GENE SEQUENCE OF L-RHAMNOSE ISOMERASE HAVING NEW CATALYTIC FUNCTION AND USE THEREOF**

Attorney Docket Number: **052800**
Customer Number: **38834**

RESPONSE TO RESTRICTION REQUIREMENT

September 11, 2006

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in response to the Official Action dated July 11, 2006.

In the Action, restriction is required between Group I, Claims 1-5, 10-12, Group II, Claims 6-9, and Group III, claims 13-16.

Applicant(s) hereby elect(s) the subject matter of **Group II, Claims 6-9** for prosecution in this application. This election is made **with traverse** as set forth below.

Specifically, it is submitted that the present application is a US national stage of a PCT application, so the standard of unity of invention applies. The requirement of unity of invention is satisfied when there is a technical relationship among claims involving one or more of the same or corresponding special technical features. The expression "special technical features" means the technical features that define a contribution which each of the claimed inventions makes over the prior art. See 37 CFR § 1.475(a).

Here, the Office Action refers to the rule on "unity of invention" under PCT Rule 13 but the rule being applied is an "independent and distinct" rule as for regular US applications. 37 C.F.R. 1.499 and the Manual of Patent Examining Procedure (MPEP) directs that "[w]hen making a lack of unity of invention requirement, the examiner must (1) list the different groups of claims and (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group" (MPEP 1893.03(d)). Thus, the restriction requirement is insufficient on this point.

In particular, it is alleged in the Office Action that Group I and Group III lack unity of invention because "product of Group I is neither used or [sic] produced by the method of Group III" and "this product [of Group II] can be used in other methods [than the methods of Group III] having other technical features." However, a product and a process "specially adapted" for the manufacture of a product have unity of invention, and "[t]he expression 'specially adapted' does not imply that the product could not also be manufactured by a different process" (MPRP 1893.03(d)). Here, the product of claim 1 is especially adapted to be used in the process of claim 13, so the restriction between Group I and Group III is improper.

A similar reasoning applies to Groups II and III, where the process of claim 13 is especially adapted to the manufacture of the product of claim 6, so that the restriction between these groups is also improper.

Additionally, the restriction requirement between Group I and Group II is also improper because, contrary to the interpretation set forth in the Office Action, the claims of Group II are not anticipated by Korndoerfer et al., J. Mol. Biol. (2000) 300, 917-933 (Korndoerfer).

Specifically, Korndoerfer relates to the rhamnose isomerase from *E. coli*, whereas the present invention relates to an enzyme derived from Pseudomonas stutzerii which makes it possible to produce D-allose from D-psicose. This enzyme does not have homology with the gene sequences encoding L-rhamnose isomerases which had been reported previously, which lacked this capacity, as discussed in details in the present specification, and as illustrated by the differences between SEQ ID NO:2 in the present invention and the sequence on Fig. 4 of Korndoerfer.

In view of the above, it is submitted that the restriction requirement should be withdrawn.

Further, it is understood that Applicants' rights to the filing of a divisional application directed to the non-elected subject matter under 35 U.S.C. §120 and 35 U.S.C. §121 are retained.

If this paper is not timely filed, Applicant(s) respectfully petition(s) for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

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